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EXAMINER

KUPSTAS, TOD A

ART UNIT PAPER NUMBER

2153

DATE MAILED: 02/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 12

Application Number: 09/556,978

Filing Date: 4/24/00

Appellant(s): Young-Nam OH

John Stowe

For Appellant

Art Unit: 2153

EXAMINER'S ANSWER

This is in response to the appeal brief filed 11/27/2002.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

Art Unit: 2153

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

The rejection of claims 1-3, 19, 23, and 24 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

5,959,946

TOGNAZZINI

9-1999

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2153

2. Claims 1-3, 19, 23, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Admitted Prior art, as disclosed on pages 1 and 2, and figure 1 of Applicant's specification, in view of Tognazzini (US 5,959,946).

As set forth in claim 1, The Admitted prior art discloses a hybrid disc comprising: a substrate; a label printed surface (A) formed on said substrate; a first recording surface (B, the CD layer), said first recording surface being formed at a first interval below said label printed surface; and a second recording surface (C, the DVD layer) formed at a second interval below said label printed surface; wherein said second interval is longer than said first interval (the DVD layer is further down).

As set forth in claim 2, the Admitted prior art discloses a hybrid disc wherein said first recording surface is a CD recording surface on which CD data is recorded (layer B), and said second recording surface is a DVD recording surface on which DVD data is recorded (Layer C).

As set forth in claim 19, the Admitted prior art discloses a hybrid disc comprising: a substrate; a first recording surface (layer B) formed at a first level in said substrate; and a second recording surface formed at a second level in said substrate, said second recording surface (layer C) including a second format type of reproduction data (the DVD layer) different from said first type of reproduction data.

As set forth in claim 23, the Admitted prior art discloses a disc wherein one of said first and second recording surfaces is a CD recording surface (Layer B).

As set forth in claim 24, the Admitted prior art discloses a disc wherein one of said first and second surface is a DVD recording surface (Layer C).

Art Unit: 2153

As set forth in claims 1, 3, and 19, the Admitted prior art does not disclose having a ID information in a predetermined area indicating the type of disk that it is. Tognazzini discloses a type of hybrid disc wherein there is an area where information indicating the type of disc to played is contained in a special area; see col. 6, lines 33-38. Furthermore this area can be different optical mediums e.g. a writable and readable optical medium in the separate layers; see col. 4, line 63- col. 5, line 4, or one layer can be different than the standard optical format (see abstract). It would have been obvious to a person of ordinary skill in the art at the time this invention was made to have provided the hybrid disc of the Admitted prior art, with an area identifying the type of disc, as taught by Tognazzini. The rationale is as follows: It would have been desirable to have informed the disc player as to which format was located on the disc. As Tognazzini teaches the desirability of having the ID information recorded in an area of the disc, one of ordinary skill would have been motivated by Tognazzini's teaching to have provided the Hybrid disc of the Admitted prior art with ID information thereby having provided means for facilitating the reproduction of discs in the player.

(11) Response to Argument

Appellant's argument focuses on whether or not Tognazzini discloses having information in a predetermined recording area of the disk which expresses a disc type. Appellant points to the sections indicated by the Examiner and notes that the "term *control information* as used at col. 6, line 34, and as used in the previous sentence at col. 6, line 31, does not refer to information included on the disk as asserted by the Examiner, but as disclosed at col. 6, lines 21-22, refers to information to be kept on RAM 410B of an apparatus showing FIG. 4." The Examiner notes that

Art Unit: 2153

the disk in Tognazzini stores information indicating the type of disk, and then the disk player in which the disk is inserted reads that information and uses it to properly access the disk. The "control information" used by Tognazzini is that information stored in the disk player's controller that interprets the data stored on the disk that indicates the type of disk used. Appellant further misstates that "the disclosure of Tognazzini teaches away from having a disc type expressed on the disc. If Tognazzini contemplated that the disc type was recorded on the disc, there would be no reason to record the serial number of the disc and the corresponding control information on the RAM 410B of the apparatus..." The Examiner contends that the serial number the Appellant refers to identifies the disk type to the player. The disk player interprets the number in order to properly use the disk. Appellant fails to recognize that the number on the disk tells the disk player what type of disk is to be played. Even if something other than a number was used on the disk in Tognazzini, the disk player must be enabled to read the information off the disk and tell the player how to access the disk.

Appellant further submits that the "present invention must be viewed in light of the problems with which the inventor was solving at the time the invention was made...." The Examiner contends that Appellant's statement is in error. Appellant's invention must be evaluated in view of the prior art and the knowledge of one of ordinary skill in the art at the time the Appellant's invention was made. Although, the problems sought to be solved by the Appellant may be important, they are not controlling.

Appellant, on page 5, argues that the combination is not proper because Tognazzini does not include recorded information in a predetermined recording area of the disc expressing a disc

Art Unit: 2153

type. As the Examiner noted above Tognazzini discloses the usage of having information identifying the disk type on the disk. One of ordinary skill would have been motivated by Tognazzini's teaching to have provided the Hybrid disc of the Admitted prior art with ID information thereby having provided means for facilitating the reproduction of discs in the player. Tognazzini as combined with the disk structure as disclosed in the Admitted prior art meet the limitations of the claims.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

AU 2153

TK

December 6, 2001

Conferrees

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